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IV. REMARKS

Applicants respectfully request consideration of the following remarks and entry of the above amendments prior to examination of this application on the merits.

1. Summary of the Amendments

Claims 1-6, 8-12 and 15 have been canceled without prejudice or disclaimer. Claims 18-28 have been added. Accordingly, upon entry of the above amendments, Claims 7, 13, 14, 16-28 will be pending for examination on the merits.

Support for Claim 7 as amended is found, for example, in on page 12, lines 11 to 16; and in Claims 1, 5, 6, 8, and 9 as originally filed.

Support for newly added Claims 18 and 19 is found, for example, on page 12, lines 11 to 16; and in Claim 6 as originally filed.

Support for newly added Claims 20, 21 and 22 is found, for example, on page 9, lines 22 to 23; and in Claim 1 as originally filed.

Support for newly added Claim 23 and 24 is found, for example, on page 5, lines 15 to 16, and page 6, line 11; and in Claim 1 as originally filed.

Support for newly added Claims 25 to 28 is found, for example, on page 13, line 15 to page 14, line 02.

In the above amendments, Applicants have focused the claimed subject matter on glycopeptides of formula II in which R²⁰ is as presently defined. The present amendments are not being made in response to any cited prior art or to meet any other cited requirements for patentability. Applicants reserve the right to pursue other aspects of this invention in subsequently filed applications. Entry of these amendments is respectfully requested.

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2. Restriction Requirement Under 35 U.S.C. §121

The Examiner has indicated that restriction to one of the following inventions is required under 35 U.S.S. §121:

- Group I Claims 1-14, drawn to the glycopeptide, is classified in class 530, subclasses 395 and 402, class 514, subclass 8, class 424, subclass 278.1.
- Group II Claim 15-17, drawn to a method of treating a mammal having a bacterial disease, are classified in class 514, subclass 8, and class 424, subclass 278.1.

In response, Applicants hereby elect Group I with traverse. Of the now pending claims, Claims 7, 13, 14 and 18-28 are believed to be within Group I; and Claims 16 and 17 are within Group II. For the following reasons, Applicants respectfully traverse the requirement for restriction of these groups.

The Examiner is required to conduct a search and examination of the entire application even though it includes claims to independent or distinct inventions, if the search and examination can be made without serious burden. See MPEP §803. In the present case, the Examiner has not indicated in any way why a search of the entire application would create a serious burden. In fact, since the compounds of this invention are antibiotics, any search for the compounds would by necessity also produce prior art relating to the use of the compounds as antibiotics. This is evidenced by the fact that the claims of Groups I and II are classified in common classes and subclasses (i.e., class 514, subclass 8, and class 424, subclass 278.1). Thus, the Examiner would not be required to search any additional classes or subclasses in order to search Group II along with Group I. Accordingly, a search and examination of the entire application can be made without serious burden and therefore, the Examiner is required to conduct such a search and examination of the entire application.

Accordingly, Applicants respectfully request that the Examiner withdraw the restriction for requirement imposed on the pending claims under 35 U.S.C. §121.

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3. Additional Election Under 35 U.S.C. §121

The Examiner has also indicated that, irrespective of whichever group Applicants may elect, Applicants are further required to elect a single glycopeptide structure to which the claims are restricted. The Examiner has then defined various groups for Formula I or II that Applicants are required to elect.

In response, Applicants elect, with traverse, the following: Formula II, where R²⁰ is -CH₂-CH(OH)CH(OH)CH₂-R¹⁷ and R¹⁷ is alkyl. For the following reasons, Applicants respectfully traverse this further requirement for restriction.

First, Applicants note that the Examiner has indicated that this further requirement for restriction "is NOT a species election, but is an additional election under 35 U.S.C. 121 since each composition is patentably distinct." (Office Action at page 3) The Examiner goes on to indicate:

"[b]ecause these inventions are distinct *for the reasons given above* and have acquired a separate status in the art *shown by their different classification, art recognized divergent subject matter, separate search*, restriction for examination purposes as indicated is proper. Office Action at page 3 (emphasis added).

However, contrary to the Examiner's statements, no specific reasons have been given why this further restriction requirement is necessary. For example, the Examiner has not shown these compounds have "different classifications" or that they are "art recognized divergent subject matter" or that "separate searches" are required. In fact, no specific information has been provided by the Examiner to support such statements.

In actuality, the groups defined by the Examiner are merely members of Markush groups defining the subject matter that Applicants regard as their invention. As such, the Examiner is required to examine all members of the Markush groups unless the subject matter lacks unity of invention. *In re Weber*, 580 F.2d 455, 198, USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978). See also MPEP §803.02.

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In the present case, the Examiner has not made any showing whatsoever that the claimed subject matter lacks unity of invention. In fact, as noted above, the Examiner has given no specific reasons for requiring this further restriction. Moreover, even if the Examiner were to show that the claimed subject matter lacked unity of invention, the proper action would be an election of species not a further restriction requirement. See MPEP §803.02

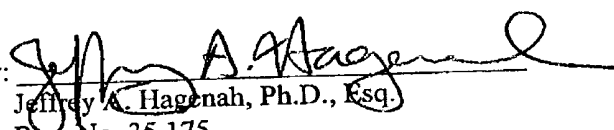
Accordingly, Applicants respectfully request that this further restriction requirement be withdrawn. Alternatively, if this further restriction requirement is maintained, Applicants respectfully request that, before making this requirement final, the Examiner make a proper showing of the necessity for the further restriction requirement under the proper rules and statutes so that Applicants have an opportunity to properly and fully respond.

Examination of this application on the merits is respectfully requested. Should there be any issues regarding this application that can be resolved by telephone, the Examiner is respectfully requested to telephone the undersigned attorney at (650) 808-6406.

Respectfully submitted,

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